CA9-99-017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: McKnight et al.

Serial No.: 09/489,793   Art Unit: 2176

Filed: January 24, 2000   Examiner: William L. Bashore

For: SYSTEM AND METHOD FOR CAPTURING DOCUMENT STYLE BY EXAMPLE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR 1.192)

1. **Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on August 19, 2004.**

    NOTE: *"The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate."* 37 CFR 1.192(a) (emphasis added).

2. **STATUS OF APPLICANT**

    This application is on behalf of

    ☒ other than a small entity

    ☐ small entity

    verified statement:

    ☐ attached

    ☐ already filed

3. **FEE FOR FILING APPEAL BRIEF**

    Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

    ☐ small entity $165.00

    ☒ other than a small entity $330.00

    Appeal Brief fee due $330.00

CERTIFICATE OF MAILING (37 CFR § 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Serena Beller
(Type or print name of person mailing paper)

Date: 9/22/04

(Signature of person mailing paper)

(Page 1 of 3)

4. EXTENSION OF TERM

> *NOTE:*   *The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).*

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

(a) ☐   Applicants petition for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
☐ one month	$ 110.00	$ 55.00
☐ two months	$ 420.00	$ 210.00
☐ three months	$ 950.00	$ 475.00
☐ four months	$ 1,480.00	$ 740.00
Fee		

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐   An extension for _____ months has already been secured and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $_____

or

(b) ☒   Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE
The total fee due is:
       Appeal Brief fee $330.00
       Extension fee (if any) $0

TOTAL FEE DUE $330.00

6. FEE PAYMENT
       ☐   Attached is a check in the sum of $____
       ☒   Charge Account No. 09-0461 (CA9-99-017) the sum of $330.00.
A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*

☒   If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 09-0461 (CA9-99-017)   AND/OR

☒   If any additional fee for claims is required, charge Account No. 09-0461 (CA9-99-017).

Reg. No.:   47,159

_____
SIGNATURE OF ATTORNEY OR PATENT AGENT

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Austin_1 251316v.1

CA9-99-017   **PATENT**

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: :   Before the Examiner:
    McKnight et al.   :   William L. Bashore

Serial No.: 09/489,793   :   Group Art Unit: 2176

Filed: January 24, 2000   :

                                      :   IBM Corporation
Title: SYSTEM AND METHOD FOR   :   P.O. Box 12195
CAPTURING DOCUMENT STYLE BY   :   Dept. T81/B503
EXAMPLE   :   Research Triangle Park, NC 27709
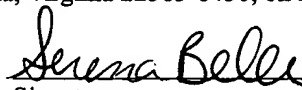
APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I.   REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is

the assignee of the entire right, title and interest in the above-identified patent application.

II.   RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   STATUS OF CLAIMS

Claims 1-13, 16-36 and 40-43 are pending in the Application. Claim 23 is allowed. Claims 1-13, 16-22, 24-36 and 40-43 stand rejected. Claims 1-13, 16-22, 24-36 and 40-43 are appealed.

IV.   STATUS OF AMENDMENTS

The Appellants' response to the Office Action having a mailing date of October 27, 2003, has been considered, but the Examiner indicated that it did not place the application in condition for allowance because Appellants' arguments were deemed unpersuasive.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

In one embodiment of the present invention, a method for formatting a document may comprise the step of receiving a user example. Specification, page 2, lines 16-17. The method may further comprise formatting the non-functional aspects of the document in the style of the user example. Specification, page 2, lines 17-18.

In another embodiment of the present invention, a method for formatting an output document may comprise the step of receiving from a user an example document. Specification, page 2, lines 19-20. The method may further comprise selectively generating from the example document style templates, alignment offsets and section order. Specification, page 2, lines 20-21. The method may further

comprise responsive to the templates, offsets and order, formatting functional aspects of the output document. Specification, page 2, lines 21-22.

In another embodiment of the present invention, a method for generating an output document in a user preferred style may comprise the step of capturing the user preferred style from a user example document. Specification, page 2, lines 23-24. The method may further comprise generating a plurality of templates, each template representing a component of the user example document and selectively including replaceable macros. Specification, page 2, line 24 – page 3, line 2.

In another embodiment of the present invention, a method for generating an output document with indentation of document components in a user preferred style may comprise the step of receiving a user example document. Specification, page 3, lines 15-16. The method may further comprise while parsing document components in the user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for the subcomponents. Specification, page 3, lines 17-18. The method may further comprise responsive to the user desired offsets, generating the output document. Specification, page 3, line 19.

In another embodiment of the present invention, a computer program product for generating an output document in a user preferred style may comprise a style capture tool for examining an input document containing an example of the user preferred style to determine the user preferred style for non-functional aspects of the output document. Specification, page 4, lines 14-17. The computer program product may further comprise a code generation tool for generating functional aspects of the output document. Specification, page 4, lines 17-18. The computer program product may further comprise a document generate tool responsive to the style capture tool and the code generation tool for generating the output document with the preferred

style for non-functional aspects applied to the presentation of the functional aspects. Specification, page 4, lines 18-20.

In another embodiment of the present invention, a computer program product for generating an output document may comprise at least one grammar template file, one grammar template file for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. Specification, page 5, lines 4-8. The computer program product may further comprise at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document. Specification, page 5, lines 8-10.

In another embodiment of the present invention, a computer program product for generating an output document may comprise at least one grammar template file, one grammar template file for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. Specification, page 5, lines 4-8. The computer program product may further comprise at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document. Specification, page 5, lines 8-10. The computer program product may further comprise a syntax template for finding and extracting style information for each section of the user example document and including a section identifier, an external pattern, an internal pattern, a before pattern, an after pattern, a repeatability indicator, and an ordering indicator, each syntax template being associated with a single style template. Specification, page 5, lines 10-14. The computer program product may further comprise a section identifier for identifying a section of the output document. Specification, page 5, lines 14-15. The computer program product

may further comprise an external pattern for finding a particular section in the input document. Specification, page 5, line 15. The computer program product may further comprise an internal pattern for indicating the textual elements to be considered as part of the particular section. Specification, page 5, lines 15-16. The computer program product may further comprise before pattern for indicating what should come before the particular section. Specification, page 5, line 17. The computer program product may further comprise after pattern for indicating what should come after the particular section. Specification, page 5, lines 17-18. The computer program product may further comprise a repeatability indicator for indicating whether the particular section is a repeatable section and, if so, that alignment offsets need to be calculated. Specification, page 5, lines 18-20. The computer program product may further comprise an ordering indicator for indicating if the particular section is part of a group of unique sections and, if so, whether the ordering of the group of unique sections is independent or whether the ordering of the group must be captured from the user example document. Specification, page 5, lines 20-22.

In another embodiment of the present invention, a computer program product for formatting a document may comprise instruction means for receiving a user example. Specification, page 5, lines 23-24. The computer program product may further comprise instruction means for formatting the non-functional aspects of the document in the style of the user example. Specification, page 5, lines 24-25.

In another embodiment of the present invention, a computer program product for formatting documents may comprise instruction means for receiving from a user an example document. Specification, page 6, lines 1-2. The computer program product may further comprise instruction means for selectively generating from the example document style templates, alignment offsets and section order. Specification, page 6, lines 3-4. The computer program product may further comprise

instruction means for, responsive to the templates, offsets and order, formatting functional aspects of the output document. Specification, page 6, lines 3-5.

In another embodiment of the present invention, a computer program product for generating an output document in a user preferred style may comprise instruction means for capturing the user preferred style from a user example document. Specification, page 6, lines 6-8. The computer program product may further comprise instruction means for generating a plurality of templates, each template representing a component of the user example document and selectively including replaceable macros. Specification, page 6, lines 8-10.

In another embodiment to the present invention, a computer program product for generating an output document with indentation of document components in a user preferred style may comprise instruction means for receiving a user example document. Specification, page 6, line 26 – page 7, line 1. The computer program product may further comprise instruction means for, while parsing document components in the user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for the subcomponents. Specification, page 7, lines 1-3. The computer program product may further comprise instruction means for, responsive to the user desired offsets, generating the output document. Specification, page 7, lines 3-4.

In another embodiment of the present invention, a system for generating an output document in a user preferred style may comprise a style capture tool for examining an input document containing an example of the user preferred style to determine the user preferred style for non-functional aspects of the output document. Specification, page 8, lines 6-9. The system may further comprise a code generation tool for generating functional aspects of the output document. Specification, page 8, line 9. The system may further comprise a document generate tool responsive to the

style capture tool and the code generation tool for generating the output document with the preferred style for non-functional aspects applied to the presentation of the functional aspects. Specification, page 8, lines 9-12.

In another embodiment of the present invention, a system for generating an output document may comprise at least one grammar template file, one grammar template file for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. Specification, page 8, lines 13-16. The system may further comprise at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document. Specification, page 8, lines 16-18.

In another embodiment of the present invention, a system for generating an output document in a user preferred style may comprise means for capturing the user preferred style from a user example document. Specification, page 8, lines 19-20. The system may further comprise means for generating a plurality of templates, each template representing a component of the user example document and selectively including replaceable macros. Specification, page 8, lines 20-22.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-8, 10-12, 16-17, 19, 24-31, 33-35, 40 and 42-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Word '97, 1996 Microsoft Corporation, screenshots pages 1-16 (hereinafter "Word '97"). Claims 9, 13, 18, 20-22, 32, 36 and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Word '97 in view of Turbo C++ Version 4.5, 1995 Borland International, screenshots pages 1-7 (hereinafter "Borland").

VII.   ARGUMENT

    A.   <u>Claims 1-8, 10-12, 16, 17, 19, 24-31, 33-35, 40, 42 and 43 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Word.</u>

The Examiner has rejected claims 1-8, 10-12, 16, 17, 19, 24-31, 33-35, 40, 42 and 43 under 35 U.S.C. §103(a) as being unpatentable over Word '97. Paper No. 9, page 2. Appellants respectfully traverse these rejections for at least the reasons stated below.

    1.   <u>Claims 1 and 24 are patentable over Word '97.</u>

Word '97 does not teach or suggest "receiving a user example; and formatting the non-functional aspects of said document in the style of said user example" as recited in claim 1 and similarly in claim 24. The Examiner cites pages 2 and 9 of Word '97 as teaching receiving a user example. Paper No. 9, page 2. The Examiner further states:

> Word '97 analyzes the following user example input: "Dear John," at which the system determines that one is attempting to write (format) a letter. A user chooses to get help, resulting in the appearance of Letter Wizard for final formatting and styling (Word '97 pages 10-15). Word '97 does not specifically disclose formatting non-functional aspects in the style of said example, as claimed. However, page 10 of Word '97 teaches a "Full block" letter style (incorporating non-functional block indent/groupings) as a default choice, which attempts to approximate the letter style display of said user input, therefore providing the claimed equivalent of formatting non-functional aspects in the style of user example input...It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 in this fashion, providing Word '97 the benefit of offering various style selections for convenience of document construction. Paper No. 9, page 3.

Appellants respectfully traverse that Word '97 teaches the above-cited claim limitations. Word '97 instead teaches that a "Letter Wizard" appears in response to

"Dear" or "To" followed by a colon or a comma with a person's name disposed between the two. Word '97, page 7. Word '97 has not received a user's example. Instead, Word '97 has received input from a user starting to type out a letter. Furthermore, Word '97 further teaches that the Letter Wizard asks the user if the user would like help writing the letter. Word '97, page 9. If the user chooses to receive help, the Letter Wizard presents various letter style options. Word '97, page 10. These are predetermined styles which are not related to the non-functional aspects of a document in the style of a user example. Indeed, the only input that has been received is the "Dear John", which contains no style information whatsoever. Additionally, the "Dear John" is a functional and not a non-functional aspect of the user input. Thus, the teaching in Word '97 does not support the Examiner's contention that the "Full block" letter style as a default choice attempts to approximate the letter style display of the user input. The displayed letter style is simply the first style displayed from a set of choices as indicated by the drop-down menu in the Letter Wizard dialog box. Word '97, page 10.

The Examiner maintains that the screenshot on page 9 (simply shows "Dear John," on a blank sheet of paper) is indicative of a "style" of type "letter." Paper No. 9, page 10. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that a blank page that shows "Dear John," is a style. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that a blank page that shows "Dear John," is a style, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 1. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Furthermore, the Examiner admits Word '97 does not teach "non-functional" aspects. Paper No. 9, page 10. The Examiner asserts that the Letter Wizard's "Full Block" letter style (page 10) can fit within the letter style of Word '97 (page 9), therefore suggesting the arrangement of non-functional aspects. Paper No. 9, page 10. Appellants respectfully traverse the assertion that by the user selecting a particular letter style is the same as formatting non-functional aspects of a document in the style of a user example. Firstly, the "Full Block" letter style is not a style of a user example. Secondly, there are no non-functional aspects in the blank page with the words "Dear John," to be formatted. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that a user selecting a particular letter style is the same as formatting non-functional aspects of a document in the style of a user example, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claim 1. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Moreover, the Examiner agrees that Word '97 does not teach formatting non-functional aspects in the style of the example as recited in claim 1. Paper No. 9, page 3. The Examiner asserts that it would have been obvious to one of ordinary skill in the art of the time of the invention to interpret Word '97 as attempting to approximate the letter style display of the user input, therefore providing the claimed equivalents of the limitations of claim 1. Paper No. 9, page 3. However, a rejection under 35 U.S.C. §103 for obviousness is not whether it would have been obvious to interpret a reference in some way, but whether the claimed invention is obvious. M.P.E.P. §2143. A *prima facie* showing of obviousness requires, at least, that the

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reference teach or suggest all of the limitations of claim 1. M.P.E.P. § 2143.03. Word '97 admittedly does not teach or suggest all of the limitations of claim 1.

Additionally, a *prima facie* showing of obviousness requires that there be some motivation or suggestion to modify the reference to make the claimed invention. M.P.E.P. § 2143.01. This suggestion must be found in the reference itself, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *Id.* The Examiner asserts, as previously discussed, that it would have been obvious to one of ordinary skill in the art to interpret Word '97 as attempting to approximate the letter style display of the user input thereby providing the claimed equivalents of formatting non-functional aspects in the style of the user example. Paper No. 9, page 3. An interpretation of a reference is not a modification of a reference. Furthermore, the rationale for interpreting Word '97 in the aforementioned fashion is to provide Word '97 the benefit of offering various style selections for convenience of document construction. Paper No. 9, page 3. However, this is not a suggestion found in one of the three possible sources thereof. Furthermore, broad conclusory statements regarding the teachings of the references, without more, are not evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d, 1430, 1433-34 (Fed. Cir. 2002). There is no reason to modify Word '97 to provide the benefit offering various style selections for convenience of document construction because Word '97 offers a choice of predetermined letter styles via a drop-down menu as explicitly shown therein. Word '97, page 10.

Lastly, a *prima facie* showing of obviousness requires that there be some reasonable expectation of success in modifying the reference to make the claimed invention. M.P.E.P. §2143.02. The reasonable expectation of success must be found in the reference itself. *Id.* No reasonable expectation of success in modifying the reference has been identified. *See* Paper No. 9, page 3.

Thus, for at least the aforesaid reasons, a *prima facie* showing of obviousness has not been made with respect to claim 1. Therefore, claim 1 is allowable under 35 U.S.C. §103 over Word '97.

2.   Claims 2 and 25 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "wherein said non-functional aspects include indentation, order, and comment style" as recited in claim 2 and similarly in claim 25. The Examiner cites pages 10, 11 and 14 of Word '97 as teaching the above-cited claim limitation. Paper No. 9, page 3. Appellants respectfully traverse and assert that Word '97 instead teaches "Full block" and "Modified block" indentation styles, as well as header and footer inclusions and space for inputting mailing instructions, attention and subjects. However, these are not non-functional aspects formatted in a style of a user example. Indeed, the only user input identified in Word '97 is "Dear John," which plainly shows that the "Full block" and "Modified block" indentation styles are not formatting in the style of the user example. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

3.   Claims 3 and 26 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "receiving from a user an example document; selectively generating from said example document style templates, alignment offsets and section order; and responsive to said templates, offsets and order, formatting functional aspects of said output document" as recited in claim 3 and similarly in claim 26. The Examiner rejects claim 3 under the same rationale as claim 1. Paper No. 9, page 3. The Examiner further cites pages 4, 10 and 11 of Word '97 as allegedly teaching the generation of various style templates based upon a user's initial attempt at writing a letter. Paper No. 9, page 3. However, the user's attempt at writing a letter is not a step of receiving from a user an

example document. Instead, Word '97 pops up a Letter Wizard in response to the user inputting a salutation in a very specific format. In other words, Word '97 performs a pattern match to pop up the Letter Wizard which then offers some exemplary predetermined document styles from which the user can select. These are not selectively generated from the example document. There is no example document received from the user. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

The Examiner also asserts that Word '97 teaches reformatting of inputted text and inclusion of macros to fit the form of a selected letter style. Paper No. 9, page 4. Again, the selected letter style is not an example document received from a user. Furthermore, macros are sets of actions that automate the performance of repetitive operations. Macros are not functional aspects of the output document. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

With respect to the alignment offsets and section order as recited in claim 3, the Examiner admits that Word '97 does not teach alignment offsets. Paper No. 9, page 3. The Examiner asserts though that "Modified Block" style includes block indentations (Word '97 page 11), that rovide the claimed equivalent of alignment offsets. Paper No. 9, page 3. Appellants respectfully traverse. The screen shots in Word '97 depicting the "modified block" letter style do not appear to show block indentations at all as asserted by the Examiner. Word '97, page 11. The depiction of the text in the letter style appears to be fully justified with paragraphs separated by additional line spacing and without indentations. Word '97, page 11. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is

relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner states that it would have been obvious to interpret Word '97 as incorporating offsets providing the benefit of various letter styles for convenience. Paper No. 9, pages 3-4. Appellants respectfully assert that the Examiner must provide objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to selectively generate from an example document style templates, alignment offsets and section order and responsive to the templates, offsets and order, formatting functional aspects of the output document. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner is simply relying upon his own subjective opinion. There is no suggestion in Word '97 to selectively generate from an example document style templates, alignment offsets and section order. Neither is there any suggestion in Word '97 in response to such templates, offsets and order, to format functional aspects of an output document. Furthermore, there is no suggestion in Word '97 to selectively generate from an example document style templates, alignment offsets and section order and in response to such templates, offsets and order, to format functional aspects of an output document in order to provide the benefit of various letter styles for convenience (Examiner's motivation). The Examiner's motivation does not address as to why one of ordinary skill in the art would have been motivated to modify the teachings of Word '97 to selectively generate from an example document style templates, alignment offsets and section order and in response to such templates, offsets and order, to format functional aspects of an output document. M.P.E.P. §2143. Furthermore, the Examiner has not indicated the source of such motivation. The Examiner must submit objective evidence indicating the source of such motivation. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently,

the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 3 and 26. *Id.*

4.   Claims 4, 27 and 42 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "capturing the user preferred style from a user example document; and generating a plurality of templates, each said template representing a component of said user example document and selectively including replaceable macros" as recited in claim 4 and similarly in claims 27 and 42. The Examiner has rejected claim 4 under the same rationale as rejecting claim 3. Paper No. 9, page 4. The Examiner further states that Word '97 does not specifically disclose replaceable macros in an output document. Paper No. 9, page 4. However, the Examiner asserts that pages 4 and 16 of Word '97 teach macro inclusion in templates and a method of selecting alternate salutations. Paper No. 9, page 4. Appellants respectfully traverse.

Selecting alternate salutations from a drop-down menu is not selectively including replaceable macros. *See* Word '97, page 16. A salutation pasted into a document from a drop-down menu is not a macro. Further, there is no teaching in Word '97 teaching or suggesting generating a plurality of templates where each template represents a component of a user example document. Further, there is no teaching in Word '97 teaching or suggesting capturing a user preferred style from a user example document. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the above-cited claim limitations "providing Word '97 the benefit of macros for convenient display of alternate text." Paper No. 9, page 4. Appellants respectfully

assert that the Examiner must provide objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to generate a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner is simply relying upon his own subjective opinion. There is no suggestion in Word '97 to generate a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros. Furthermore, there is no suggestion in Word '97 to generate a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros in order to provide the benefit of macros for convenient display of alternate text (Examiner's motivation). The Examiner's motivation does not address as to why one of ordinary skill in the art would have been motivated to modify the teachings of Word '97 to generate a plurality of templates where each template represents a component of the user example document and selectively including replaceable macros. M.P.E.P. §2143. Furthermore, the Examiner has not indicated the source of such motivation. The Examiner must submit objective evidence indicating the source of such motivation. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 4, 27 and 42. *Id.*

5.   Claims 5, 28 and 43 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "generating functional aspects; replacing said macros in said template with information from said functional aspects; and responsive to said template with information from said functional aspects, generating said output document" as recited in claim 5 and

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similarly in claims 28 and 43. The Examiner asserts that Word '97 teaches reformatting of inputted text and the inclusion of macros (functional aspects) to fit the form of the selected letter style. Paper No. 9, page 4. The Examiner also relies on the teaching in Word '97 (citing pages 4, 13 and 16 of Word '97) for selecting alternate salutations using a drop-down menu. Paper No. 9, page 4.

Whether Word '97 teaches reformatting of inputted text and the inclusion of macros to fit the form of a selected letter style, or otherwise, these allegations do not address the limitations of claim 5. Claim 5 does not recite reformatting inputted text and the inclusion of macros to fit a form of selected letter style. Likewise, the limitations of claim 5 do not recite selecting alternate salutations. Claim 5 recites, *inter alia*, replacing macros in a template with information from the functional aspects, and responsive to the template with information from the functional aspects, generating the output document. All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Examiner has not considered the language in the above-cited claim limitations, the Examiner has not appropriately judged the patentability of the claim against the prior art. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion that reformatting of inputted text and the inclusion of macros to fit the form of a selected letter style as well as selecting alternate salutations teaches any of the above-cited claim limitations. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that reformatting of inputted text and the inclusion of macros to fit the form of a selected letter style as well as selecting

alternate salutations teaches any of the above-cited claim limitations, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 28 and 43. M.P.E.P. §2143.

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6.   Claims 6 and 29 are patentable over Word '97.

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Appellants further assert that Word '97 does not teach or suggest "applying syntactical patterns to said user example document to define said component" as recited in claim 6 and similarly in claim 29. The Examiner asserts that page 2 of Word '97 teaches analysis of user input "Dear John," the analysis dependent upon syntactical review of the punctuation of the input. Paper No. 9, page 4. Appellants respectfully traverse and assert that there is no such teaching in Word '97. Word '97 simply states that if a salutation starts with "Dear" or "To" and followed by a colon or comma, Word '97 pops up a Letter Wizard that allows the user to select a letter style from a predetermined set of letter styles using a drop-down menu. There is no particular implementation described in Word '97. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion that popping up a Letter Wizard teaches applying syntactical patterns to the user example document to define the component. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that popping up a Letter Wizard teaches applying syntactical patterns to the user example document to define the component, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5 and 28. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate

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in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

7.   Claims 7 and 30 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "temporarily removing comments from said user example document when applying said syntactical patterns to said user example document" as recited in claim 7 and similarly in claim 30. The Examiner rejects claim 7 on the basis that pages 14 and 16 of Word '97 teach alteration of "mailing instructions" "Attention", and "Subject" fields as well as creating auto text after applying pattern matching. Paper No. 9, page 4.

Appellants respectfully traverse and assert that while Word '97 may teach alteration of "mailing instructions", "Attention" and "Subject" fields, by selecting an option from a list box in a dialog window, this is not the same as temporarily removing comments from the user example document when applying syntactical patterns to the example document, as recited in claim 7. It would be appreciated by persons of ordinary skill in the art that selecting elements in a list box, such as a reference line or a subject field, simply copies the text in the list box into the letter being written. *See* Word '97, pages 14, 16 (illustrating the Letter Wizard dialog box and list box contained therein). Similarly, creating auto text does not disclose the limitations of claim 7. As stated in Word '97, creating auto text allows the user to add names to a list of names and text to be used in standard letter elements. Word '97, page 5. Thus, Word '97 does not teach or suggest all of the limitations of claim 7. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

8.   Claims 8 and 31 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "said output document including a plurality of separately generated sections" as recited in claim 8 and similarly in claim 31. The Examiner asserts that pages 10-15 of Word '97 teach various sections of a document. Paper No. 9, page 5. Appellants respectfully assert that whether Word '97 teaches various sections of a document, as alleged, or otherwise, the allegation does not reach the limitations of claim 8. Claim 8 recites an output document including a plurality of separately generated sections. All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Because Word '97 is neither alleged to nor does it teach or suggest all of the limitations of claim 8, claim 8 is not *prima facie* obvious in view of Word '97. M.P.E.P. §2143.

Furthermore, the Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion that the teaching of various sections of a document teaches an output document including a plurality of separately generated sections. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that the teaching of various sections of a document teaches an output document including a plurality of separately generated sections, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8 and 31. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

9.   Claims 10 and 33 are patentable over Word '97.

As an initial matter, claim 10 is a multiple dependent claim, depending from any one of claims 4 to 9. Because claim 9 has not been rejected under 35 U.S.C. §103 over Word '97 alone, claim 10, incorporating the limitations of claim 9, is not *prima facie* obvious in view of Word '97 alone.

Appellants further assert that Word '97 does not teach or suggest "receiving from said user further input changing the style of said user example document" as recited in claim 10 and similarly in claim 33. The Examiner asserts that page 16 of Word '97 teaches revising a final document (changing its style) using a right click feature in combination with a replaceable function that is a macro feature. Paper No. 9, page 5. However, revising a final document is not changing a document style and in particular is not a step of receiving from the user further input changing the style of the user example document as recited in claim 10. Furthermore, inserting a particular salutation from a drop-down list of stored salutations, as illustrated on page 16 of Word '97, is not a replaceable function feature. (If, for the sake of argument, this were a replaceable function feature, it is not germane to the limitation of claim 10 as it does not disclose receiving from the user further input changing the style of the user example document.) Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion that revising a final document (changing its style) using a right click feature in combination with a replaceable function that is a macro feature teaches receiving from the user further input changing the style of the user example document. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that revising a final document (changing its style) using a right

click feature in combination with a replaceable function that is a macro feature teaches receiving from the user further input changing the style of the user example document, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 10 and 33. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

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10. Claims 11 and 34 are patentable over Word '97.
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Again, as an initial matter, claim 11 is a multiple dependent claim depending from, *inter alia*, claims 9 and 10. As previously discussed, claim 9 has not been rejected over teaching in Word '97 alone. Therefore, claim 11, incorporating the limitations of claim 9, cannot be *prima facie* obvious in view of Word '97 alone.

Appellants further assert that Word '97 does not teach or suggest "wherein said replaceable macros correspond to text in said user example document" as recited in claim 11 and similarly in claim 34. The Examiner asserts that page 16 of Word '97 teaches a replaceable function feature that is a macro. Paper No. 9, page 5. As previously discussed, page 16 illustrates the selection of a salutation in a letter from a drop-down list of salutations previously used by the user. This is not the same as replaceable macros. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's assertion that the selection of a salutation in a letter from a drop-down list of salutations previously used by the user teaches that

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replaceable macros correspond to text in the user example document. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that the selection of a salutation in a letter from a drop-down list of salutations previously used by the user teaches that replaceable macros correspond to text in the user example document, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 11 and 34. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

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11.   Claims 12 and 35 are patentable over Word '97.

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Appellants further assert that Word '97 does not teach or suggest "receiving a user example document; while parsing document components in said user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for said subcomponents; and responsive to said user desired offsets, generating said output document" as recited in claim 12 and similarly in claim 35.

The Examiner asserts that page 11 of Word '97 teaches a "Modified block" style template that allegedly comprises various calculated block indents in which the desired application of the template to a user document preserves the indents to produce a final document. Paper No. 9, page 5. Appellants respectfully traverse and assert that Word '97 instead teaches a sample letter style including a modified block letter style selected from a set of predetermined letter styles. Word '97, page 11. There is no language disclosed in the cited passage of Word '97 that teaches calculating various block indents as asserted by the Examiner. Neither does this passage teach or suggest receiving a user example document or while parsing

document components in the example document, preserving the relative indentation of subcomponents or responsive to the user desired offsets, generating the output document, as recited in claim 12.

Furthermore, the Examiner admits that Word '97 does not teach parsing components. Paper No. 9, page 5. The Examiner contends that Word '97 teaches analyzing user inputted words and punctuation which provides the claimed equivalent of parsing text components. Paper No. 9, page 5. Appellants respectfully disagree. As previously discussed, Word '97 detects the presence of a "Dear" or "To" followed by a comma or colon, and launches the Letter Wizard in response thereto. This is not the same as parsing document components in a user example document. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that launching a Letter Wizard teaches parsing components. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that launching a Letter Wizard teaches parsing components, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 12 and 35. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As also previously discussed, there is no user example document disclosed in Word '97. Thus, the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as providing the equivalent of parsing text components is not justified.

Furthermore, obviousness is not shown by interpreting a reference to meet the claim limitations but by what a reference actually teaches. The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d at 1343-44, 61 U.S.P.Q.2d at 1434.

Furthermore, as stated above, a *prima facie* showing of obviousness requires that there be some motivation or suggestion to modify the reference to make the claimed invention. M.P.E.P. §2143.01. This suggestion must be found in the reference itself, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *Id*. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to interpret Word '97 to make the invention of claim 12 thereby providing the benefit of analysis/matching for presentation of various templates. Paper No. 9, page 5. An interpretation of a reference is not a modification of a reference. Furthermore, the rationale for interpreting Word '97 in the aforementioned fashion is to provide Word '97 the benefit of analysis/matching for presentation of various templates. Paper No. 9, page 5. However, this is not a suggestion found in one of the three possible sources thereof. Furthermore, broad conclusory statements regarding the teachings of the references, without more, are not evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d, 1430, 1433-34 (Fed. Cir. 2002). Consequently, claims 12 and 35 are allowable under 35 U.S.C. §103 over Word '97.

Lastly, a *prima facie* showing of obviousness requires that there be some reasonable expectation of success in modifying the reference to make the claimed invention. M.P.E.P. §2143.02. The reasonable expectation of success must be found in the reference itself. *Id*. No reasonable expectation of success in modifying the reference has been identified. *See* Paper No. 9, page 5.

Thus, for at least the aforesaid reasons, a *prima facie* showing of obviousness has not been made with respect to claims 12 and 35. Therefore, claims 12 and 35 are allowable under 35 U.S.C. §103 over Word '97.

12. Claims 16 and 40 are patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "a style capture tool for examining an input document containing an example of said user preferred style to determine said user preferred style for non-functional aspects of said output document; a code generation tool for generating functional aspects of said output document; and a document generate tool responsive to said style capture tool and said code generation tool for generating said output document with said preferred style for non-functional aspects applied to the presentation of said functional aspects" as recited in claim 16 and similarly in claim 40. Claim 16 has been rejected on the grounds that claim 16 reflects computer readable instructions for performing the methods of claim 3. Paper No. 9, page 5. However, as an initial matter, the limitations of claim 16 do not only parallel the limitations of claim 3 as computer constructions for performing the methods of claim 3. For example, claim 3 does not recite determining a user preferred style for non-functional aspects of an output document generating functional aspects of the output document (claim 3 recites formatting functional aspects of the output document) or generating the output document with the preferred style for non-functional aspects applied to the presentation of the functional aspects. These elements of claim 16 have not been expressly addressed. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. §2142. Since the Examiner has not met his burden of presenting evidence that Word '97 teaches or suggests all of the limitations of claims 16 and 40, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 40. M.P.E.P. §2142.

Furthermore, the Examiner states that while Word '97 does not specifically disclose formatting non-functional aspects in the style of the example, page 10 of Word '97 teaches a "Full block" letter style as a default choice. Paper No. 9, page 5. There is no language in claim 16 that recites "formatting non-functional aspects." All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Examiner has ignored claim language from claims 16 and 40, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 40. M.P.E.P. §2143.

Furthermore, Appellants respectfully traverse the assertion that page 10 of Word '97 teaches any of the limitations of claim 16. Instead, Word '97 teaches that the Letter Wizard offers the user a drop-down menu selection of predetermined letter styles. Word '97, page 10. Thus, the "Full block" letter style does not attempt to approximate the letter style display of the user input, but is simply one choice from a predetermined set of choices of letter style offered to the user by Word '97. Consequently, there is no justification for interpreting Word '97 to teach the limitations of claims 16 and 40. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the limitations of claim 16 since it would provide Word '97 the "benefit of offering various style selections or convenience of document construction." Paper No. 9, page 6.

As stated above, a *prima facie* showing of obviousness requires that there be some motivation or suggestion to modify the reference to make the claimed invention. M.P.E.P. §2143.01. This suggestion must be found in the reference itself, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *Id.* The Examiner asserts that it would have been obvious to one of ordinary skill in the art to interpret Word '97 to make the invention of claim 16 thereby providing the "benefit of offering various style selections for convenience of document construction". Paper No. 9, page 6. However, this is not a suggestion found in one of the three possible sources thereof. Furthermore, broad conclusory statements regarding the teachings of the references, without more, are not evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d, 1430, 1433-34 (Fed. Cir. 2002). Consequently, claims 16 and 40 are allowable under 35 U.S.C. §103 over Word '97.

Lastly, a *prima facie* showing of obviousness requires that there be some reasonable expectation of success in modifying the reference to make the claimed invention. M.P.E.P. §2143.02. The reasonable expectation of success must be found in the reference itself. *Id.* No reasonable expectation of success in modifying the reference has been identified. *See* Paper No. 9, page 6.

Thus, for at least the aforesaid reasons, a *prima facie* showing of obviousness has not been made with respect to claims 16 and 40. Therefore, claims 16 and 40 are allowable under 35 U.S.C. §103 over Word '97.

13.   Claim 17 is patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "a grammar template for storing syntax rules; and said style capture tool being responsive to said syntax rules for pattern-matching said user example document" as recited in claim 17. The Examiner admits that Word '97 does not teach a grammar template for storing syntax rules. Paper No. 9, page 6. The Examiner asserts that Word '97 teaches

analysis of user input "Dear John," in which the analysis is dependent upon syntactical and pattern matching review of words and punctuation of the input. *Id.* Appellants respectfully disagree that the analysis is dependent upon syntactical matching, and moreover, that notwithstanding, there is no disclosure in Word '97 with respect to a grammar template. As Appellants have previously discussed, Word '97 teaches that the Letter Wizard is launched in response to user inputting "Dear" or "To" followed by a comma or a colon. Word '97, page 7. The Letter Wizard will not start if anything else is entered. *Id.* The starting of Letter Wizard can be responsive to a simple pattern matching and need not rely on syntactical rules. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word '97 as teaching the limitations of claim 17 since it would provide Word '97 the "benefit of rules for making accurate analysis". Paper No. 9, page 6. As stated above, a *prima facie* showing of obviousness requires that there be some motivation or suggestion to modify the reference to make the claimed invention. M.P.E.P. §2143.01. This suggestion must be found in the reference itself, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *Id.* The Examiner asserts that it would have been obvious to one of ordinary skill in the art to interpret Word '97 to make the invention of claim 17 thereby providing the "benefit of rules for making accurate analysis". Paper No. 9, page 6. However, this is not a suggestion found in one of the three possible sources thereof. Furthermore, broad conclusory statements regarding the teachings of the references, without more, are not evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d, 1430, 1433-34 (Fed. Cir. 2002). The "benefit of rules for making accurate analysis" is not a clear and particular suggestion

or motivation, as required. *See In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433-34. Consequently, claim 17 is allowable under 35 U.S.C. §103 over Word '97.

Lastly, a *prima facie* showing of obviousness requires that there be some reasonable expectation of success in modifying the reference to make the claimed invention. M.P.E.P. §2143.02. The reasonable expectation of success must be found in the reference itself. *Id.* No reasonable expectation of success in modifying the reference has been identified. *See* Paper No. 9, page 6.

Thus, for at least the aforesaid reasons, a *prima facie* showing of obviousness has not been made with respect to claim 17. Therefore, claim 17 is allowable under 35 U.S.C. §103 over Word '97.

14.   Claim 19 is patentable over Word '97.

Appellants further assert that Word '97 does not teach or suggest "a plurality of input document files, each said input document file representing a user preferred style for different parts of said output document" as recited in claim 19. The Examiner has rejected these limitations based on the teaching in Word '97 of a Letter Wizard that can be used to modify or complete existing letters, each letter capable of incorporating various customized template portions. Paper No. 9, page 6. Whether Word '97 teaches such, a Letter Wizard or otherwise, is immaterial to the rejection of claim 19. Claim 19 recites a plurality of input document files, each input document file representing a user preferred style for different parts of the output document. The Examiner must consider all words in a claim when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Examiner ignored the language in claim 19 in judging the patentability of claim 19, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner

is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

15.   Conclusion.

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1-8, 10-12, 16, 17, 19, 24-31, 33-35, 40, 42 and 43. M.P.E.P. §2143.

B.   Claims 9, 13, 18, 20-22, 32, 36 and 41 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Word '97 in view of Borland.

The Examiner has rejected claims 9, 13, 18, 20-22, 32, 36 and 41 under 35 U.S.C. §103(a) as being unpatentable over Word '97 in view of Borland. Paper No. 9, page 7. Appellants respectfully traverse these rejections for at least the reasons stated below.

1.   The Examiner has not provided any objective evidence for combining Word '97 with Borland.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Word '97 with Borland to generate the output document with public, protected and private member access in the user preference order, as recited in claim 9 and similarly in claim 32, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Paper No. 9, page 7. Further, the Examiner's motivation for modifying Word '97 with Borland to have the user desired offsets being preserved for variables, functions and constructors, as recited in claim 13 and similarly in claim 36, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Paper No. 9, page 7. Further, the Examiner's motivation for modifying Word '97 to have a plurality of grammar templates, as recited in claim 18, is to provide Word '97 "the benefit of rules for making accurate analysis." Paper No. 9, page 7. Further, the Examiner's motivation for modifying Word '97 with Borland to have a plurality of grammar templates, each template for storing syntax rules for a unique one of a plurality of programming languages, as recited in claim 18, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Paper No. 9, page 8. Further, the Examiner's motivation for modifying Word '97 with Borland to have input document files include a declaration example file and a definition example file, as recited in claim 20, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Paper No. 9, page 8. Further, the Examiner's motivation for modifying Word '97 with Borland to have a code generation tool for generating class declarations as well as to have a style capture tool for providing to a document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations, as recited in claim 21, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files." Paper No. 9, page 8. Further, the Examiner's motivation for modifying Word '97 to have at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document, as recited in claim 22 and

similarly in claim 41, is to provide Word '97 "the benefit of text analysis/matching for presentation of various templates." Paper No. 9, page 9. Further, the Examiner's motivation for modifying Word '97 with Borland to have a grammar template for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document, as recited in claim 22 and similarly in claim 41, is to provide Word '97 "the benefit of enhancing its templates to accommodate various text files for programmers." Paper No. 9, page 9. These motivations are insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The motivations must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that these motivations comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivations are insufficient to support a *prima facie* case of obviousness for rejecting claims 9, 13, 18, 20-22, 32, 36 and 41. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Word '97, which teaches a Letter Wizard which can help a user write a letter more quickly and easily (page 2 of Word '97), with Borland, which teaches (1) an auto indent mode to help you keep your program code more readable (page 3 of Borland); (2) a persistent blocks option (page 4 of Borland) used in an environment for Turbo C++ programming; and a (3) block indent field, used in an environment for Turbo C++ programming, which allows the user to

specify the number of characters blocks are indented (page 5 of Borland). *Id.* There is no suggestion in Word '97, a word processing tool, of having an auto indent mode to help you keep your program code more readable. Neither is there any suggestion in Word '97 of having a persistent blocks option or a block indent field used in an environment for writing program code. Since the Examiner has not submitted objective evidence for modifying Word '97 with Borland, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 9, 13, 18, 20, 21, 22, 32, 36 and 41. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to generate the output document with public, protected and private member access in the user preference order (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of generating an output document with public member access. Neither is there any suggestion in Word '97 of generating an output document with protected member access. Neither is there any suggestion in Word '97 of generating an output document with private member access. Neither is there any suggestion in Word '97 of generating an output document with public, protected and private member access in the user preference order. Since the Examiner has not submitted objective evidence for modifying Word '97 to generate the output document with public, protected and private member access in the user preference order, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 9 and 32. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have the user desired offsets being preserved for variables, functions and constructors (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of having desired offsets being preserved for variables. Neither is there any suggestion in Word

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'97 of having desired offsets being preserved for functions. Neither is there any suggestion in Word '97 of having desired offsets being preserved for constructors. Since the Examiner has not submitted objective evidence for modifying Word '97 to have the user desired offsets being preserved for variables, functions and constructors, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 13 and 36. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have a plurality of grammar templates (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of having a grammar template. Since the Examiner has not submitted objective evidence for modifying Word '97 to have a plurality of grammar templates, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 18. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have a plurality of grammar templates, each template for storing syntax rules for a unique one of a plurality of programming languages (Examiner admits that Word '97 does not teach this limitation). *Id.* As stated above, there is no suggestion in Word '97 of having a grammar template. Neither is there any suggestion in Word '97 for having a template for storing syntax rules. Neither is there any suggestion in Word '97 for having a template for storing syntax rules for a programming language. Since the Examiner has not submitted objective evidence for modifying Word '97 to have a plurality of grammar templates, each template for storing syntax rules for a unique one of a plurality of programming languages, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 18. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have input document files include a declaration example file and a definition example file (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of having an input document file including a declaration example file. Neither is there any suggestion in Word '97 of having an input document file including a definition example file. Since the Examiner has not submitted objective evidence for modifying Word '97 to have input document files include a declaration example file and a definition example file, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 20. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have a code generation tool for generating class declarations as well as to have a style capture tool for providing to a document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of generating class declarations. Neither is there any suggestion in Word '97 of providing rules for syntax. Neither is there any suggestion in Word '97 of providing rules for ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations. Since the Examiner has not submitted objective evidence for modifying Word '97 to have a code generation tool for generating class declarations as well as to have a style capture tool for providing to a document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 21. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have at least one style

template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of having a template. Neither is there any suggestion in Word '97 of having a style template parsed from a user example document. Neither is there any suggestion in Word '97 of having a style template parsed from a user example document in a user preferred style. Neither is there any suggestion in Word '97 of having a style template parsed from a user example document in a user preferred style using a grammar template file. Neither is there any suggestion in Word '97 of having a style template parsed from a user example document in a user preferred style using a grammar template file for defining the style of a section of the output document. Since the Examiner has not submitted objective evidence for modifying Word '97 to have at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 22 and 41. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Word '97 to have a grammar template for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document (Examiner admits that Word '97 does not teach this limitation). *Id.* There is no suggestion in Word '97 of having a template. Neither is there any suggestion in Word '97 of having a grammar template for each section of an output document. Neither is there any suggestion in Word '97 of having a grammar template for each section of an output document in a programming language. Neither is there any suggestion in Word '97 of having a grammar template file for specifying the manner for parsing. Neither is there any suggestion in Word '97 of having a grammar template file for specifying the manner

for defining the bounds of a section of the output document. Since the Examiner has not submitted objective evidence for modifying Word '97 to have a grammar template for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 22 and 41. *Id.*

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 9, 13, 18, 20-22, 32, 36 and 41. M.P.E.P. §2143.

    2.   Word '97 and Borland, taken singly or in combination, do not teach or suggest the following claim limitations.

        a.   Claims 9 and 32 are patentable over Word '97 in view of Borland.

Appellants respectfully assert that Word '97 and Borland, taken singly or in combination, do not teach or suggest "determining from said user example document a user preference for group order; and generating said output document with public, protected, and private member access in said user preference order" as recited in claim 9 and similarly in claim 32. The Examiner contends that Word '97 teaches group ordering in disclosing a header and footer. Paper No. 9, page 7. Further, the Examiner admits that Word '97 does not teach public, protective and private member access associated with an order. Paper No. 9, page 7.

Considering the assertion with respect to group order, the Examiner provides no rationale explaining how a header and a footer teach the recited group order, and moreover, claim 9 is not directed to "group order" standing alone. Claim 9 recites determining from the user example document a user preference for group order. As previously discussed, there is no teaching in Word '97 respecting a user example document and, consequently, there can be no teaching with respect to determining

from a user example document, a user preference for group order. Certainly, there is no teaching in Word '97 that a header and footer are determined from a user example document, and no such teaching would be expected as there is nothing to "order" with respect to a header and footer, by definition. A header is at the top of the page and a footer at the bottom; there is nothing to determine with respect to a user preference.

The Examiner asserts that Borland teaches public, protected and private member access as recited in claim 9. Paper No. 9, page 7. The Examiner refers to language in Borland that allegedly teaches the customization of reserve words, for example by color or underlining, with the reserve words comprising "public," "private" and "protected." Paper No. 9, page 7. Although Appellants do not dispute that "public," "private" and "protected" are reserved words in C++, there is no language in Borland that teaches or suggests generating an output document with public, private and protected member access in user preference order. The Examiner contends that the customization of coloring, etc., to reserved words can be interpreted as a form of prioritized ordering. Paper No. 9, page 7. There is no support for the Examiner's interpretation of coloring or other highlighting of reserved words as a prioritized ordering. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that coloring or other highlighting of reserved words teaches a user preference order. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that coloring or other highlighting of reserved words teaches a user preference order, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 32. M.P.E.P. §2143. Instead, the Examiner is relying upon an incorrect, factual predicate in support of the rejection which is insufficient to support a *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, there is no teaching or suggestion in Borland with respect to generating an output document with public, protected and private member access in a user preference order. There is no ordering/prioritization of C++ text of Borland. Borland simply teaches syntax highlighting that lets the user choose the color and style of text that the editor uses to display syntax elements in C++ source code. Borland, page 6. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

> b.   Claims 13 and 36 are patentable over Word '97 in view of Borland.

Appellants further assert that Word '97 and Borland, taken singly or in combination, do not teach or suggest "said user desired offsets being preserved for variables, functions, and constructors" as recited in claim 13 and similarly in claim 36. The Examiner rejects claims 13 and 36 based on Borland teaching an auto indent mode and persistent blocks for preserving indentation of blocks of code. Paper No. 9, page 7. Appellants respectfully traverse the rejections.

Referring first to the persistent blocks option, when the persistent blocks option is on, marked blocks remain selected until they are deleted or unmarked or another block is selected. Borland, page 4. Otherwise, with this option off, moving the cursor after a block that is selected deselects the entire block of text. Borland, page 4. Therefore, persistent blocks have nothing to do with the preservation of indentation of blocks of code as asserted by the Examiner. With respect to the auto indent mode, when auto indent mode is on in Borland, pressing enter in an edit window positions the cursor under the first non-blank character in the preceding non-blank line. Borland, page 3. Thus, Borland does not teach preserving user desired offsets for variables, functions and constructors. Neither does Borland teach while parsing a user example document, preserving the relative indentation of

subcomponents by calculating user desired offsets for the subcomponents, as recited in claim 12 from which claim 13 depends. Plainly, neither Word '97 nor Borland teach or suggest all of the limitations of claim 13. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

        c.   <u>Claim 18 is patentable over Word '97 in view of Borland.</u>

Appellants further assert that Word '97 and Borland, taken singly or in combination, do not teach or suggest "a plurality of grammar templates, each said template for storing syntax rules for a unique one of a plurality of programming languages" as recited in claim 18. The Examiner admits that Word '97 does not teach a grammar template for storing syntax rules. Paper No. 9, page 7. The Examiner contends (citing Word '97, page 2), however, that Word '97 teaches analysis of user input "Dear John," which analysis is dependent upon syntactical and pattern matching review of the words and punctuation of the input. Paper No. 9, page 7. Appellants have addressed this assertion in conjunction with claim 17. Appellants have previously shown that Word '97 does not suggest an analysis dependent upon syntactical and pattern matching review of words and punctuation of the input. Further, there is no language in either Word '97 or Borland that refers to syntax rules as recited in claim 18. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner admits that Word '97 does not teach rules for programming languages or of declaration/definition files. Paper No. 9, page 8. While Appellants agree with the Examiner's statement, the statement is not pertinent to the invention of claim 18. Claim 18 does not refer to rules for programming languages or

declaration/definition files. Claim 18 recites a template for storing syntax rules for a unique one of a plurality of programming languages. Neither does the Examiner's allegation with respect to Borland as teaching an editor specifically tailored to edit text, as well as editing C++ text files, comprising declaration/definition files address the limitations of claim 18. Paper No. 9, page 8. A text editor for editing declaration files is not a template for storing syntax rules for a unique one of a plurality of programming languages. Neither are declaration/definition files as would be recognized by persons of ordinary skill in the C++ programming art. Declaration/definition files, commonly referred to as header files, are not templates for storing syntax rules as recited in claim 18. As is well known in the art, C and C++ are strongly typed languages in which all variables, functions, etc. must be declared as to type before they are defined. Commonly this is done in a header file, and further, it is standard practice to denote header files with a .h file extension. Thus, neither Word '97 nor Borland, alone or in combination, teach or suggest the limitations of claim 18. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

> d.   Claim 20 is patentable over Word '97 in view of Borland.

Appellants further assert that Word '97 and Borland, taken singly or in combination, do not teach or suggest "said input document files including a declaration example file and a definition example file" as recited in claim 20. The Examiner cites pages 1, 6 and 7 of Borland as teaching the above-cited claim limitations since Borland allegedly teaches an edit specifically tailored to edit text, as well as editing C++ text files, comprising declaration/definition files, e.g., #include<stdio.h>. Paper No. 9, page 8. Appellants respectfully traverse.

Appellants do not dispute that the text editor of Borland might be used to edit declaration files, such as `stdio.h`. However, a text editor is not an input file nor is a C++ header file either a declaration example file or a definition example file. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

e.   Claim 21 is patentable over Word '97 in view of Borland.

Appellants further assertion that Word '97 and Borland, taken singly or in combination, do not teach or suggest "wherein said code generation tool is operable for generating class declarations, and said style capture tool is operable for providing to said document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations" as recited in claim 21. The Examiner admits that Word '97 does not teach generation of class declarations, etc., as recited in claim 21. Paper No. 9, page 8. The Examiner cites pages 1, 6 and 7 of Borland as teaching the above-cited claim limitations since Borland allegedly teaches a text editor specifically tailored to edit text and editing and dealing with the specialized constructs within C++ text files. Paper No. 9, page 8. However, a text editor is not a code generation tool and is not operable for generating class declarations. Neither is it a style capture tool operable for providing to the document generation tool, rules for syntax and ordering of class-head, base-specifiers, etc., as recited in claim 21. Text editors are software programs that create and edit files in response to keystrokes entered by the user and display the entered text on a display, and may save that text to a file in response to a user input command, such as "save." Text editors, as understood in the art, are not a tool operable for generating class-declarations nor a tool operable for providing rules for syntax in ordering of class-head, base-specifiers, etc., as recited in claim 21. There are no teachings in Borland with respect to rules and constructs and in particular with respect to rules for

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syntax in ordering as recited in claim 21. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

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f.   Claims 22 and 41 are patentable over Word '97 in view of Borland.

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Appellants further asserts that Word '97 and Borland, taken singly or in combination, do not teach or suggest "at least one grammar template file, one said grammar template file for each of one or more sections of an output document in one or more programming languages, each said grammar template file for specifying the manner for parsing and defining the bounds of a section of said output document; and at least one style template parsed from a user example document in a user preferred style using said grammar template file for defining the style of a section of said output document" as recited in claim 22 and similarly in claim 41.

The Examiner contends that Word '97 teaches analysis of user input "Dear John," the analysis dependent upon syntactical and grammatical review of the words and punctuation of the input, which purportedly teaches the limitation in claim 22 directed to "grammar." Paper No. 9, page 9. Appellants respectfully disagree.

Word '97 teaches that the user enters "Dear" or "To" followed by a name and colon or comma. Word '97, page 2. Word '97 further teaches that if the Letter Wizard does not start in response, the user did not enter a comma or colon after the person's name or the user misspelled "Dear" or "To". Word '97, page 7. There is no language in Word '97 that teaches syntactical and grammatical review of the words and punctuation of the input.

Furthermore, the Examiner admits that Word '97 does not teach parsing. Paper No. 9, page 9. Nevertheless, the Examiner contends that Word '97 teaches

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analyzing initial user inputted words and punctuation which provides the equivalent of parsing text components. Paper No. 9, page 9. This allegation fails as indicated below.

As an initial matter, asserting that Word '97 teaches analyzing initial user inputted words and punctuation is an overstatement of the teaching in Word '97. Word '97 teaches that if the user enters "Dear" or "To" followed by a name followed by a colon or comma, the "Letter Wizard" will start and ask the user if the user would like help. Word '97, pages 2, 7, 9. There is no evidence to support the alleged analysis of inputted words and punctuation, and indeed, the demonstration above contradicts this assertion.

Furthermore, Appellants respectfully assert that claim 22 does not recite parsing of components, but a grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. All words in a claim must be considered when judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. Since the Examiner has not considered all the words in claim 22 in judging the patentability of claim 22, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22. M.P.E.P. §2143.

Furthermore, the Examiner admits that Word '97 does not teach templates for programming languages. Paper No. 9, page 9. As an initial matter, this does not address the limitations of claim 22. Claim 22 does not recite templates for programming languages, without more. All words in the claim must be considered when judging the patentability of the claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. 2143.03. The foregoing notwithstanding, the Examiner contends that Borland teaches a text editor for editing text and C++ programming files. Paper No. 9, page 9. Whether Borland does teach

such a text editor is immaterial to the rejection of claim 22. There is no evidence, or even an allegation that Borland teaches templates as recited in claim 22.

Accordingly, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 22 and 41.

> g.   Additional reasons claims 9, 13, 18, 20-21, 32 and 36
> are patentable over Word '97 in view of Borland.

Claim 9 depends from claims 4 to 8 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claims 4-8. Further, claim 13 depends from claim 12 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claim 12. Further, claim 18 depends from claim 17 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claim 17. Further, claim 20 depends from claim 19 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claim 19. Further, claim 21 depends from claims 16 to 20 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claims 16-19. Further, claim 32 depends from claims 27 to 31 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claims 27-31. Further, claim 36 depends from claim 35 and thus is patentable over Word '97 in view of Borland for at least the reasons stated in Section A with respect to claim 35.

h.   Conclusion.

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9, 13, 18, 20-22, 32, 36 and 41. M.P.E.P. §2143.
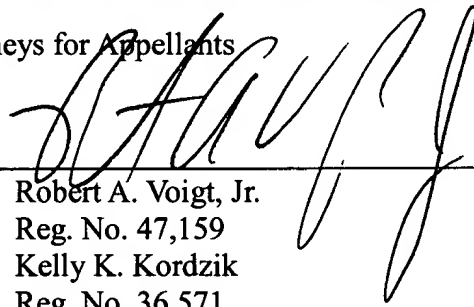
VIII. CONCLUSION

For the reasons noted above, the rejections of claims 1-13, 16-22, 24-36 and 40-43 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-13, 16-36 and 40-43.

Respectfully submitted,

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APPENDIX

1.   A method for formatting a document, comprising the steps of:

receiving a user example; and

formatting the non-functional aspects of said document in the style of said user example.

2.   The method of claim 1 wherein said non-functional aspects include indentation, order, and comment style.

3.   A method for formatting an output document, comprising the steps of:

receiving from a user an example document;

selectively generating from said example document style templates, alignment offsets and section order; and

responsive to said templates, offsets and order, formatting functional aspects of said output document.

4.   A method for generating an output document in a user preferred style, comprising the steps of:

capturing the user preferred style from a user example document; and

generating a plurality of templates, each said template representing a component of said user example document and selectively including replaceable macros.

5.   The method of claim 4, further comprising the steps of:

generating functional aspects;

replacing said macros in said template with information from said functional aspects; and

responsive to said template with information from said functional aspects, generating said output document.

6.   The method of claim 4 or claim 5, further comprising the step of applying syntactical patterns to said user example document to define said component.

7.   The method of claim 6, further comprising the step of temporarily removing comments from said user example document when applying said syntactical patterns to said user example document.

8.   The method of any one of claims 4 to 7, said output document including a plurality of separately generated sections.

9.   The method of any one of claims 4 to 8, further comprising the steps of:

determining from said user example document a user preference for group order; and

generating said output document with public, protected, and private member access in said user preference order.

10.   The method of any one of claims 4 to 9, further comprising the step of receiving from said user further input changing the style of said user example document.

11.   The method of any one of claims 4 to 10, wherein said replaceable macros correspond to text in said user example document.

12.   A method for generating an output document with indentation of document components in a user preferred style, comprising the steps of:

receiving a user example document;

while parsing document components in said user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for said subcomponents; and

responsive to said user desired offsets, generating said output document.

13.   The method of claim 12, said user desired offsets being preserved for variables, functions, and constructors.

16.   A computer program product for generating an output document in a user preferred style, said computer program product comprising:

a style capture tool for examining an input document containing an example of said user preferred style to determine said user preferred style for non-functional aspects of said output document;

a code generation tool for generating functional aspects of said output document; and

a document generate tool responsive to said style capture tool and said code generation tool for generating said output document with said preferred style for non-functional aspects applied to the presentation of said functional aspects.

17.   The computer program product of claim 16, further comprising:

a grammar template for storing syntax rules; and

said style capture tool being responsive to said syntax rules for pattern-matching said user example document.

18.   The computer program product of claim 17, further comprising a plurality of grammar templates, each said template for storing syntax rules for a unique one of a plurality of programming languages.

19.   The computer program product of any one of claims 16 to 18, further comprising a plurality of input document files, each said input document file representing a user preferred style for different parts of said output document.

20.   The computer program product of claim 19, said input document files including a declaration example file and a definition example file.

21.   The computer program product of any one of claims 16 to 20, wherein said code generation tool is operable for generating class declarations, and said style capture tool is operable for providing to said document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations.

22.   A computer program product for generating an output document, said computer program product comprising:

        at least one grammar template file, one said grammar template file for each of one or more sections of an output document in one or more programming languages, each said grammar template file for specifying the manner for parsing and defining the bounds of a section of said output document; and

        at least one style template parsed from a user example document in a user preferred style using said grammar template file for defining the style of a section of said output document.

23.   A computer program product for generating an output document, said computer program product comprising:

at least one grammar template file, one said grammar template file for each of one or more sections of an output document in one or more programming languages, each said grammar template file for specifying the manner for parsing and defining the bounds of a section of said output document;

at least one style template parsed from a user example document in a user preferred style using said grammar template file for defining the style of a section of said output document;

a syntax template for finding and extracting style information for each section of said user example document and including a section identifier, an external pattern, an internal pattern, a before pattern, an after pattern, a repeatability indicator, and an ordering indicator; each said syntax template being associated with a single style template;

said section identifier for identifying a section of said output document;

said external pattern for finding a particular section in said input document;

said internal pattern for indicating the textual elements to be considered as part of said particular section;

said before pattern for indicating what should come before said particular section;

said after pattern for indicating what should come after said particular section;

said repeatability indicator for indicating whether said particular section is a repeatable section and, if so, that alignment offsets need to be calculated; and

said ordering indicator for indicating if said particular section is part of a group of unique sections and, if so, whether the ordering of said group of unique sections is independent or whether the ordering of said group must be captured from said user example document.

24.   A computer program product for formatting a document, said computer program product comprising:

instruction means for receiving a user example; and

instruction means for formatting the non-functional aspects of said document in the style of said user example.

25.   The computer program product of claim 24 wherein said non-functional aspects include indentation, order, and comment style.

26.   A computer program product for formatting documents, said computer program product comprising:

instruction means for receiving from a user an example document;

instruction means for selectively generating from said example document style templates, alignment offsets and section order; and

instruction means for, responsive to said templates, offsets and order, formatting functional aspects of said output document.

27.   A computer program product for generating an output document in a user preferred style, said computer program product comprising:

instruction means for capturing the user preferred style from a user example document; and

instruction means for generating a plurality of templates, each said template representing a component of said user example document and selectively including replaceable macros.

28.   The computer program product of claim 27, further comprising:

instruction means for generating functional aspects;

instruction means for replacing said macros in said template with information from said functional aspects; and

instruction means for, responsive to said template with information from said functional aspects, generating said output document.

29.   The computer program product of claim 27 or claim 28, further comprising instruction means for applying syntactical patterns to said user example document to define said component.

30.   The computer program product of claim 29, further comprising the step of instruction means for temporarily removing comments from said user example document when applying said syntactical patterns to said user example document.

31.   The computer program product of any one of claims 27 to 30, said output document including a plurality of separately generated sections.

32.   The computer program product of any one of claims 27 to 31, further comprising:

        instruction means for determining from said user example document a user preference for group order; and

        instruction means for generating said output document with public, protected, and private member access in said user preference order.

33.   The computer program product of any one of claims 27 to 32, further comprising instruction means for receiving from said user further input changing the style of said user example document.

34.   The computer program product of any one of claims 27 to 33, wherein said replaceable macros correspond to text in said user example document.

35.   A computer program product for generating an output document with indentation of document components in a user preferred style, said computer program product comprising:

        instruction means for receiving a user example document;

instruction means for, while parsing document components in said user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for said subcomponents; and

instruction means for, responsive to said user desired offsets, generating said output document.

36.   The computer program product of claim 35, said user desired offsets being preserved for variables, functions, and constructors.

40.   A system for generating an output document in a user preferred style, comprising:

a style capture tool for examining an input document containing an example of said user preferred style to determine said user preferred style for non- functional aspects of said output document;

a code generation tool for generating functional aspects of said output document; and

a document generate tool responsive to said style capture tool and said code generation tool for generating said output document with said preferred style for non-functional aspects applied to the presentation of said functional aspects.

41.   A system for generating an output document, comprising:

at least one grammar template file, one said grammar template file for each of one or more sections of an output document in one or more programming languages, each said grammar template file for specifying the manner for parsing and defining the bounds of a section of said output document; and

at least one style template parsed from a user example document in a user preferred style using said grammar template file for defining the style of a section of said output document.

42.   A system for generating an output document in a user preferred style, comprising:

means for capturing the user preferred style from a user example document; and

means for generating a plurality of templates, each said template representing a component of said user example document and selectively including replaceable macros.

43.   The system of claim 42, further comprising:

means for generating functional aspects;

means for replacing said macros in said template with information from said functional aspects; and

means for, responsive to said template with information from said functional aspects, generating said output document.